

REMARKS

Summary of the Claims

With the present Office Action, claims 1 and 3-7 are pending in the application. Claim 6 has been noted as constituting allowable subject matter, and claims 1, 3-5, and 7 have been rejected. The Applicant respectfully traverses all of the rejections in the Office Action.

With the present amendments, claims 8-16 have been added. After entry of the above amendments, claims 1 and 3-16 will be pending in the application.

Allowable Subject Matter

The indication, in the Office Action, that claim 6 constitutes patentable subject matter, is noted with appreciation.

Objections to the Specification

The Office Action has objected to the specification for failing to reference the related PCT application. In accordance with 35 USC 371 a national stage application may not claim benefit of the filing date of the international application of which it is the national stage. Accordingly, it is not necessary to amend the first sentence of the specification to reference the international application. Therefore, Applicant respectfully requests the objection to the specification be withdrawn.

Objections to the Drawings

The Office Action has objected to the drawings for including reference numeral "24," though the specification never describes or otherwise refers to reference numeral 24. The Applicant has amended the drawings to remove reference numeral 24 from Figure 1. A Replacement Sheet is submitted herewith. The Applicant submits that the amendment to the drawings has rendered this objection moot.

Objections to the Claims

The Office Action has objected to claim 1 due to perceived informalities. The claim has been amended, without prejudice, to replace the word "it" with the phrase "said seal portion." It is noted that this amendment does not affect the scope of claim 1. The Applicant submits that this amendment has rendered the objection to claim 1 moot.

Amendments to the Claims

As noted above, claim 1 has been amended to address perceived informalities. Additionally, claims 1, 3, and 7 have been amended. Claims 8-16 have been added. No new matter has been added by any of these amendments.

Rejection Under 35 U.S.C. § 102

Claim 7 has been rejected under 35 U.S.C. § 102(b) over U.S. Pat. No. 5,356,010 to *Weinstein*.

Weinstein is directed to a cutting assembly with a flap and a cutting tool attached thereto. The cutting tool is operated by pivoting the flap about a hinge. Amended claim 7 recites, *inter alia*, that the cutting member is operated by slideably translating an article past at least a portion of the cutting member, a feature that *Weinstein* does not teach or suggest.

Since *Weinstein* does not teach this feature, and since any rejection under 35 U.S.C. § 102 must show each and every element of the claims, the rejection over *Weinstein* fails, and cannot be maintained. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)(holding that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.").

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Rejections Under 35 U.S.C. § 103

Claims 1, 3-5, and 7 have been rejected under 35 U.S.C. § 103(a) over U.S. Pat. No. 5,332,096 in view of *Weinstein* (supra).

In the Office Action,¹ two references are cited as teaching certain features of claims 1, 3-5, and 7. For the reasons cited below, this proposed combination fails, the Office Action has failed to establish a *prima facie* case of obviousness, and the rejections must therefore be withdrawn. *M.P.E.P.* § 2142 (8th ed. Rev. 6, September, 2007).

THERE IS NO SUPPORT IN THE RECORD FOR THE PROPOSED COMBINATION

Battaglia is directed to a mouthwash capsule and *package apparatus*. In the disclosure, the *package apparatus* is explained, described, illustrated, and claimed as including the cutting assembly illustrated in figures 5-8. The *package apparatus* of *Battaglia* has been used in the Office Action in an attempt to show obviousness of certain features of the claims of this application. In particular, the Office Action asserts that the cutting assembly of *Battaglia* demonstrates the claimed channel, cutting member, etc.

Since, as conceded in the Office Action, *Battaglia* does not teach all of the features of the claims, the Office Action attempts to rely on *Weinstein* as teaching, in a proposed combination with *Battaglia*, several features of the claims. For at least the following reasons, this proposed combination is improper, the rejections under 103 therefore fail, and the claims are patentable over the cited references.

When arguing for the proposed combination, the Office Action states that “[i]t would have been obvious to a person of ordinary skill in the art to provide *Battaglia*’s cutting apparatus with the container, as taught by *Weinstein*, in order to store articles within the container.” This statement is completely unsupported by the record. The mere statement that a proposed combination “would have been obvious,” without any support from the record or any of the references, is

¹ See page 4, ¶ 7.

insufficient to maintain a rejection under 35 U.S.C. § 103. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (BPAI 1993)(holding that “rejections on obviousness cannot be sustained by mere conclusory statements...”); *M.P.E.P.* § 2143.01. As no evidence is provided for any motivation or need to combine the cited references, the rejections under 35 U.S.C. § 103 should be withdrawn.

THE PROPOSED COMBINATION FAILS FOR ADDITIONAL REASONS

Even though the proposed combination is unsupported by any teaching, suggestion, or motivation to combine in the record, the proposed combination, even if valid, would still fail. The teachings of *Weinstein* and *Battaglia* are not combinable, as will now be explained in detail.

THE REFERENCES ARE NOT COMBINABLE AS APPLIED

First, the proposed combination fails since there would be no motivation to combine the cited references. One of “ordinary skill in the art” would have absolute *no need or motivation to combine Weinstein with Battaglia*. There is nothing that *Battaglia* can add to *Weinstein*. *Weinstein* already includes an opening apparatus, as illustrated in all of the figures of *Weinstein*. Since *Weinstein* describes the opening apparatus as sufficient for accomplishing *Weinstein*’s intended goal, there would be no motivation for one “of ordinary skill in the art,” confronted with the teaching of *Weinstein*, to search the art for a cutting tool. The Office Action also provides no support, and certainly no “clear articulation of [any] reason” that one of “ordinary skill in the art” would be motivated to combine *Battaglia* with *Weinstein*, in this case, by replacing the cutting apparatus of *Weinstein* with the cutting apparatus of *Battaglia*. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385, 1396 (2007)(citing *In re Kahn* 441 F.3d 977, 988 (Fed. Cir. 2006))(holding that there must be a clear articulation of the reasons why a claimed invention would be obvious; merely combining references is insufficient).

THE PROPOSED COMBINATION DESTROYS FUNCTIONALITY OF BOTH REFERENCES

Second, the proposed combination would destroy the functionality of both *Battaglia* and *Weinstein*, contrary to the requirements of sustaining a rejection under 35 U.S.C. § 103. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)(reversing the rejection since the proposed combination would have rendered one of the cited references inoperable for the reference's intended purpose); M.P.E.P. § 2143.01. The rework required to combine the two references would render both of the references inoperable.

If *Weinstein* is modified and/or combined as the Office Action has proposed, *Weinstein* would be inoperable for its intended purpose. *Weinstein* describes and illustrates the top segment² as a flap or door that is designed to be nested into a depression³ formed in the package.⁴ When a user wishes to open a blister package, the blister pack is placed into an aperture⁵ in the package, and the flap is pressed onto the package to puncture the seal.⁶ As such, the package is intended to have a rectangular shape when closed, as explicitly claimed in *Weinstein*'s claim 16. The proposed combination would require modification or removal of the cutting assembly, the flap, and the rectangular shape of *Weinstein*, present in each of the illustrated features and present in some or all claims of the application.

Similarly, the *Battaglia* reference would be inoperable for its intended purpose if modified and/or combined as the Office Action has proposed.

Battaglia, as explained above, teaches a cutting assembly⁷ for opening a

² Reference numeral 6 in figures 1-4. As with this element, the embodiment illustrated in figures 1-4 of *Weinstein* are used, since the embodiments of figures 5-6 and 7 are substantially similar.

³ Reference numeral 2 of figures 1-4 of *Weinstein*.

⁴ Reference numeral 1 of figures 1-4 of *Weinstein*.

⁵ Reference numeral 4 in figures 1-4 of *Weinstein*.

⁶ Column 4, lines 21-30 of *Weinstein*.

⁷ Reference numeral 18 in figure 5-7 of *Battaglia*.

package, a roller⁸ that “permits ease of directing the cutter assembly 18 towards the individual packages of the package strip...,”⁹ a blade handle¹⁰, and a plurality of walled structures through which a package strip is inserted. The roller and the plurality of walled structures are included to hold the package strip and the cutting assembly in the proper configuration so that the cutting apparatus can operate as intended. As such, these features are necessary to the function of *Battaglia*.

The Office Action argues that the cutting assembly of *Battaglia* can be “provided with the container [of *Weinstein*].” Aside from the fact, stated above, that there would be no reason to combine the cited references, this proposed combination would defeat at least at least two objects of *Weinstein*, *i.e.*, to provide a rectangular package for opening blister packages, and the flap feature that allows the opening tool to be concealed within the package, thereby making the package rectangular. In other words, if the opening tool of *Weinstein* were to be replaced with the cutting assembly of *Battaglia*, then the blade handle of the *Battaglia* cutting assembly would project away from the package, thereby destroying the rectangular shape of *Weinstein*, and preventing the flap of *Weinstein* from closing over the now-protruding cutting handle.

If the cutting assembly of *Battaglia* were attached to a package, *e.g.*, the proposed combination with *Weinstein*, then the roller and the plurality of walled structures of *Battaglia* would serve absolutely no purpose, since these structures are intended to hold the package strip. Similarly, the blade and blade handle of *Battaglia* would have to be redesigned or removed.

Therefore the proposed combination fails for another reason, *i.e.*, since combining the references, or features thereof, in the proposed method would require that certain features be removed from both references. These

⁸ Reference numeral 28, visible in figures 7-8.

⁹ Column 3, lines 45-50 of *Battaglia*.

¹⁰ Reference numeral 26 of figure 6.

modifications would destroy features, and thereby, the intended purpose, of both references. *In re Gordon*, 733. F.2d 900.

THE PROPOSED COMBINATION WOULD REQUIRE “SUBSTANTIAL RECONSTRUCTION AND REDESIGN” OF BOTH REFERENCES

Finally, substantial changes would need to be made to both of the references to achieve any sort of combination. These changes would require “substantial reconstruction and redesign” of both *Battaglia* and *Weinstein*, contrary to the limitations imposed on any analysis under 35 U.S.C. § 103. *In re Ratti*, 270 F.2d 810, 813 (C.C.P.A. 1959). As explained above, the entire cutting assembly of *Weinstein* would need to be removed, including the flap that provides the claimed “rectangular shape.” This, in turn, would render the *Weinstein* package as nothing more than a rectangular box. Similarly, the roller, the plurality of walled structures, and the blade handle of *Battaglia* would need to be removed, thereby rendering the *Battaglia* cutting assembly as nothing more than a blade. As if these modifications are not enough, even the blade itself would need to be redesigned since the blade of *Battaglia* is designed to engage a blister as it is moved *toward* the blade. These (and possibly other) modifications are yet another reason that the rejections under 35 U.S.C. § 103 are improper and must be withdrawn.

For at least these four reasons discussed above, the Office Action fails to meet the burden required for demonstrating a proper rejection under 35 U.S.C. § 103. Therefore, these rejections should be withdrawn.

Patentability of the New Claims

The new claims 8-16 are patentable over the prior art cited in this application for at least the reasons discussed above. There is nothing in any of the cited references that precludes patentability of each of the new claims.

CONCLUSION

It is respectfully submitted that the claims in condition for allowance, and notice to that effect is requested. If Examiner Alie has any additional concerns, Examiner Alie is respectfully urged to contact the undersigned representative at the phone number listed below.

It is believed that there are no fees due with the filing of this communication. If there are any fees resulting from this communication, please charge same to our Deposit Account No. 50-3447.

Respectfully Submitted,
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